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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,495	06/18/2001	Dennis C. Smith	1512C USW 0632 PUS	5187
22193	7590	02/23/2005	EXAMINER	
QWEST COMMUNICATIONS INTERNATIONAL INC LAW DEPT INTELLECTUAL PROPERTY GROUP 1801 CALIFORNIA STREET, SUITE 3800 DENVER, CO 80202			TRAN, CONGVAN	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,495

Applicant(s)

SMITH ET AL.

Examiner

CongVan Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13, 15-17, 19-24, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 6, 12, 14, 18, 25 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is in response to Amendment filed on Jan. 13, 2005.

#### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-12 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U. S. Patent No. 6,836,662 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: receiving identification of a subscriber; determining a preferred connection; and connecting.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Specification***

5. The disclosure is objected to because of the following informalities: In specification

-“wireline interface 28” should be change to “wireline interface 26 “.

- “the ACs 18” should be change to “the ACs 20 “.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Mauger (5,345,498).

Regarding claims 1-5, and 7-11, Mauger discloses a method for connecting a wireless handset to a wireline switch (see fig.2, elements BTS, 1, 2, and its description) in an integrated wireline/wireless telecommunications network (see figs.1- 2, and its

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description) having a plurality of access controllers and wireline switches each of the access controllers being coupled to at least one of the wireline switches (see fig.2, elements 1, 11, 2, 10 and its description), the method comprising: receiving identification of a subscriber in response to a call attempt (see fig.3, PCN number 01X YYYYY ZZZZ, col.3, lines 30-31 and its description); determining a preferred connection between the wireless handset and one of the plurality of wireline switches based on predetermined data associated with the subscriber (see fig.3. PCN number and operator discriminator, 01X, col.3, lines 32-33 and its description); and connecting the wireless handset to one of the plurality of wireline switches based on the preferred connection so as to complete the call attempt (see fig.3 elements 20, 21, 22, col.3, lines 34-49 and its description).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 13, 15-17, 19-24, 26, 28-29, is rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al (6,134,341).

Regarding claim 13, Dougherty discloses a method and system for dynamically redirecting wireline call delivery, comprising a wireless service location register identifying the subscriber with one of the wireline switches and identifying the subscriber with a feature group representing features subscribed by the subscriber (see abstract fig.1, elements 16, 20, 26, col.3, lines 20-60 and its description); at least one access controller in communication with the wireless handset and with at least one wireline

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switch, each access controller operative to switch a call between the handset and one wireline switch based on the handset subscriber feature group (see fig.1, elements 16, 20, 24, 28, col.3, lines 20-60 and its description) ; an access manager in communication with wireless service location register and each access controller, the access manager selecting an idle port on the access controller switching the call (see abstract, fig.1, element SCP 20, and its description).

Regarding claims 15-17, Dougherty further discloses the access manager maintains a busy/idle status of all port within each feature group (see abstract, elements 16, 18, 20, 24, 26, 28, col.3, lines 20-60 and its description)

Regarding claim 19, Dougherty discloses a method and system for dynamically redirecting wireline call delivery, comprising: receiving a subscriber identification in response to a call attempt (see abstract, elements 24, 16 and its description); associating the subscriber with one of a plurality of feature groups, each feature group representing features subscribed to the subscriber, the associate based on the subscriber identification (see fig.1, element 28, 24, 26, col.3, lines 20-60 and its description) determining one of the plurality of switches based on the subscriber identification (see abstract, fig.1, element SCP 2, col.3, lines 20-60 and its description); connecting the call to the handset and one of the wireline switches based on the associated subscriber feature group (see fig.1, elements 28, 24, 26, 16 and its description).

Regarding claims 20-24, Dougherty, further disclose associating the subscriber with one of the feature groups comprises associating in a wireless location register (see fig.1, element 26 and its description).

Regarding claims 26, and 28-29 Dougherty discloses a method and system for dynamically redirecting wireline call delivery, comprising: identifying, in a wireless service location register, the subscriber with one of the wireline switches (see abstract, fig.1, elements 26, 16 and its description); identifying, in the wireless service location register, the subscriber with a feature group representing features subscribed to by the subscriber (see abstract, fig.1, elements 26, 16, col.3, lines 20-60 and its description); and switching a call between the handset and the identified wireline switch in an access controller in communication with the wireless handset and identified wireline switch, the switching based on the identified feature group (see fig.1, elements 28, 24, 16 and its description)

***Allowable Subject Matter***

9. Claims 6, 12, 14, 18, 25, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CongVan Tran whose telephone number is 703-305-4024. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CONGVAN TRAN  
PRIMARY EXAMINER

CongVan Tran  
Examiner  
Art Unit 2683

TCU  
Feb. 17, 2005.